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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/334,843	11/04/94	DRORI	Z 392.6

WELDON, U
EXAMINER

E6M1/0626

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ART UNIT	PAPER NUMBER
2609	14

DATE MAILED: 06/26/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☑ Responsive to communication(s) filed on June 12, 1996.

☑ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 95, 96, 98-110 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 95, 96, 98-110 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 76

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The terminal disclaimer filed 6/12/96 has been entered; and, it has overcome the obviousness double patenting rejection of claims 95, 96, 98-110.

3. Applicant's arguments filed June 12, 1996 have been fully considered but they are not deemed to be persuasive.

Mr. Ze'ev Drori states in his Fifth declaration, "Clifford from time to time (typically only once a year) had promoted a clearance sale of old and discontinued remote control security systems of which many did not include the invention. From the foregoing it's amply clear that the outstanding commercial success of my invention is not due to special incentives offered by Clifford." The above statements suggest some of the systems sold during clearance sales included applicant's invention.

If some of the clearance units included the invention; it can be stated that such units could possibly constitute an incentive because of price differences between applicant's units and other units. Such prices and their differences have not been clearly stated. Next, it has never been shown that the units sold during the clearance sales did not constitute part of the increase in yearly sales noted by applicant. Note they took place "typically only once a year." Typically suggests sales

could have occurred more than once a year. Such would have increase sales by a "possible incentive".

The Declaration sets forth that "Clifford's security systems are intended for professional installation, which is performed by technicians employed by the retail dealers". It has never been clearly stated how the dealers find out about the Clifford's security systems.

Once more applicant has stated, "several vehicle manufacturers are selling new vehicles equipped with remote control security systems incorporating my invention." At such a point, applicant has stated, "I do not have access to the vehicle manufacturer's records so specific sales information cannot be provided but I know of no one who can show that any car maker sold a system incorporating my invention before the 1990 models".

First, note an invention is defined by the claims in an application. Second, applicant has not shown that each limitation in his claims can find a corresponding element or limitation in each system in his Exhibits A and B. Third applicant has not established that each claimed limitation can be found in the Clifford's after market system. Fourth, in view of the above statements, it is not clear as to what applicant is referring to as "my invention".

If General Motors and other car companies use a system similar to applicant's invention, it has not been established

when they started using such system. Also, it has not been shown how sales of the car companies cars with such systems similar to applicant's invention correlate to the "year by year" increase in sales of the Clifford's system.

In short, the Declaration by the applicant does not: 1) clearly define what applicant defines as "my invention"; 2) clearly establish over what period the sales occurred; 3) clearly show that no incentives were used to increase sales; 4) clearly show how long Clifford has used applicant's invention in all model. Please see the Office action mailed March 12, 1996 for a response to applicant's previous declarations.

Applicant Declarations have been fully considered but they are not deemed to be persuasive.

Applicant has stated, "The import attached to the word "MAY" by the Examiner is at odds with the explicit teachings of he reference" (i.e. Pinnow). In view of this and all the statements by applicant with respect to the reference, "a reference is to be considered not only for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill in the art. "See In re DeLisle, 160 USPQ 806.

Applicant has stated that column 4, lines 31-42 "does not suggest arming after receipt of an authorized code and subsequent disarming if another received code is correct." The examiner concurs with applicant's statement. However, column 4, lines 31-

42 of Pinnow does suggest arming on receiving a code be it an authorized code or not. This section of Pinnow further suggests that when the arming code is an authorized code, a disarming act will take place and the lock will open.

Pinnow teaches a control unit with a digital memory (col. 9, line 19) which can be programmed by a transmitting unit. PINNOW IN COLUMN 2, LINES 1-3 DISCLOSES THAT IT WAS KNOWN IN THE ART TO PROGRAM A TRANSMITTER DURING MANUFACTURING. In column 3, lines 16-18, Pinnow suggests the transmitter MAY be reprogrammed. This suggests the transmitter need not be reprogrammed or can be preprogrammed during manufacturing.

Sander et al have been cited to indicate that arming and disarming means have been long known in the art (see decision below). Also, as previously pointed out, "Applicant does not deny that, as of the effective filing date of this application, remote control vehicle security systems were known, which were armed or disarmed by the remote transmitter".

Factual Reference Need Not Antedate

In re Langer, 183 USPQ 288 (CCPA 1974)

Even though effective date, for prior art purposes, of many of the references is subsequent to applicant earliest filing date, the references are properly-cited for purpose of showing a fact.

In re Wilson, 135 USPQ 442 (CCPA 1962)

A bulletin published by a chemical company could be used as evidence of factual characteristics of prior art in foam products in determining patentability of a process for making foamed polyester materials, even though date of the publication was later than the filing date of the patent applicant.

Applicant has recognized, "whether the user programs the card or not is not addressed by the reference (i.e. Aydin)". Hence, it is obvious that a user or anyone could preprogram the unit.

To eliminate Sander et al as reference, applicant's declaration should show his invention predates Sanders et al application serial number 588,575 filed March 12, 1984. Further, "Applicant does not deny that, as of the effective filing date of this application, remote control vehicle security systems were known, which were armed or disarmed by the remote transmitter."

Applicant has erroneously stated that the dependent claims. "stand allowable as patentably distinct from the invention of claim 95." Pinnow ('046) suggests program switch accessible. As pointed out above, manufacturer encoding is not precluded by the art of record.

In view of the above statements, the previous rejection will here be repeated.

4. Claims 95, 96, 98-110 are rejected under 35 U.S.C. § 103 as being unpatentable over Pinnow ('046) in view of Aydin, Tolson, and Sanders et al.

Pinnow teaches an electronically programmable remote control vehicle (column 4, lines 43-47) security (e.g. locking) system comprising a portable hand-held (e.g. pencil watch. See column 3, line 6) transmitter comprising means (column 2, line 55) for generating and transmitting a determined digitally encoded receiver signal or signals (column 3, lines 14-16), actuating means 24 for actuating said generating and transmitting means (column 3, lines 35-40 suggest plural key or transmitting means)

so that said signal or signals are automatically generated and transmitted; a system control unit to obviously be disposed within said vehicle comprising receiving means 48 operable during a system program mode and a system operating-receiving mode for receiving said transmitted encoded signal and generating an electrical signal representative of the encoded signal by amplifier 50; a digital memory (column 9, lines 17-25) for storing data representative of control signal; programming and operating means 52. Pinnow does not teach a radio frequency system.

At the time that the invention was made, Tolson (column 3, lines 53-62) had disclosed the interchangeability of a light and radio system. One of ordinary skill in the art having Tolson would readily find obvious that the teaching in Tolson could be used to substitute a radio signal for a light signal in Pinnow.

In column 2, lines 50-54, Pinnow points out that his invention can be used to replace a card. Aydin (column 9, lines 30-32) teaches a predetermined time delay means which can be used in a programmable security system. Since Pinnow's invention can be substituted for a card in Aydin, the teaching in Aydin can obviously be used in Pinnow because their teachings are interchangeable.

In column 6, lines 4-6, Pinnow suggests the next code received by a lock from a transmitter will reprogram the lock and

the transmitter can have minimum features. The key 15 in Aydin has a minimum of features and is preprogrammed as set forth in the claims. As set forth in column 4, lines 29-34 of Aydin, the preprogrammed key can reprogram a lock as suggested in Pinnow. These preprogram and reprogram codes would not be known by a user as required by the claims. Aydin also uses such a wireless key in column 3, lines 66-67.

One of ordinary skill in the art having Aydin would be motivated to use a minimum feature transmitter as suggested in Aydin in Pinnow.

At the time that the invention was made, the patent to Sanders et al, in view of the interchangeable wireless teaching in Tolson, had disclosed that a wireless unit as set forth in Pinnow could be used to arm or disarm a security device.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. Weldon whose telephone number is (703) 305-4389. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-8576.

U. Weldon/skf
June 24, 1996

ULYSSES WELDON
PRIMARY EXAMINER
GROUP 2600